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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,924

10/16/2003

Gary S. Hess

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06/28/2007

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.

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SUITE 1030

MILWAUKEE, WI 53202

EXAMINER

DESHPANDE, KALYAN K

ART UNIT

PAPER NUMBER

3623

NOTIFICATION DATE

DELIVERY MODE

06/28/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@boylefred.com

**Office Action Summary**

Application No.

10/686,924

Applicant(s)

HESS ET AL.

Examiner

ABUL K. AZAD

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-36 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-36 are pending in this Office Action.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/806,604. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application are directed to similar claimed invention using same steps, therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to change language without any criticality of the invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-13, 15-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagahara (US 2002/0042790).

As per claim 1, Nagahara teaches, “a method of identifying a translation service in response to a translation request”, the method comprising the acts of:

“registering a plurality of translation services with a moderator” (Fig. 1, element 100 “content distribution terminal” as claimed “moderator” and Fig. 2, elements 40, 42 and 44);

“creating a corresponding profile for each of the plurality of translation services in a database of the moderator, each profile having at least one key characterizing the translation service” (Fig. 6);

“receiving at the moderator a translation request from a user” (Fig. 6); and

“matching at least one of the profiles with the translation request using the at least one key” (Fig. 8).

As per claim 2, Nagahara teaches, “wherein the matching act includes the acts of: identifying at least one key characterizing the translation request; comparing the at least one key characterizing the translation service with the at least one key characterizing the translation request; and determining each of the plurality of

translation services having the at least one key characterizing the translation service that matches the at least one key characterizing the translation request” (Fig. 3).

As per claim 3, Nagahara teaches, “wherein the moderator includes a website in communication via an internet connection with the translation service and the user making the translation request” (paragraph 0069).

As per claim 4, Nagahara teaches, “wherein the registering act includes entering requested data into one or more entries of a first software defined user template on the website” (paragraph 0072).

As per claim 5, Nagahara teaches, “wherein the requested data includes a contact information and a list of documents translated by the translation service” (paragraph 0074).

As per claim 6, Nagahara teaches, “wherein the receiving act includes entering requested data entered into one or more entries of a second software defined template on the website, the requested data including a contact information and one or more keys characterizing the translation request” (paragraph 0074).

As per claim 7, Nagahara teaches, “wherein the at least one key of the profile of the translation service includes titles of previously translated documents by the respective translation service” (paragraph 0089).

As per claim 8, Nagahara teaches, “displaying to the user an identification of one or more candidate translation services and an indication of occurrences of the at least one key characterizing the respective candidate translation service that matches one or more of the at least one key characterizing the translation request” (paragraph 0092).

As per claim 9, Nagahara teaches, "receiving a selection of at least one candidate translation service from the identification of the one or more candidate translation services; recalling the contact information of the at least one selected candidate translation service from the database; and providing the contact information of the selected candidate translation service to the user " (paragraph 0092).

As per claim 10, Nagahara teaches, "wherein the creating tile profile of the translation service act includes the acts of: transmitting a software package to configure each translation services computer to detect a number occurrences of the at least one key characterizing the translation service" (paragraph 0092); and

"providing the number of occurrences of the at least one key characterizing the translation service to the database via an internet connection" (Fig. 3).

As per claim 11, Nagahara teaches, "wherein the creating act further includes storing the detected number in the profile of the translation service in the database" (Fig. 3).

As per claim 12, Nagahara teaches, "wherein the at least one key characterizing the translation service is indicative of a characteristic of at least one translated document" (paragraph 0093).

As per claim 13, Nagahara teaches, "wherein the characteristic of the at least one translated document is one or more of a group including an identifying number, an identifying word and an identifying phrase" (Fig. 3).

As per claim 15, Nagahara teaches, "wherein the key characterizing tile translation service includes one or more terms characterizing a previously translated document of the translation service" (Fig. 3).

As per claim 16, Nagahara teaches, "wherein the identifying at least one key characterizing the translation request act includes the steps of: using a software package operable to configure a processor to count a number occurrences of the at least one key characterizing the translation request" (Fig. 3).

As per claim 17, Nagahara teaches, "wherein the software package is operable to configure a processor to provide the number of occurrences of the at least one key characterizing the translation request to the website" (Fig. 3).

As per claim 18, Nagahara teaches, "wherein the identifying at least one key characterizing the translation request act includes receiving a designated term entered into an entry of a software configured template of the website" (paragraph 0069).

As per claim 19, Nagahara teaches, "wherein the determining act includes using fuzz matching" (paragraph 0082).

As per claims 20-36, they are interpreted and thus rejected for the same reasons set forth in the rejection of claims 1-13 and 15-19.

***Allowable Subject Matter***

6. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Contact Information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Abul K. Azad** whose telephone number is **(571) 272-7599**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Patric Edouard**, can be reached at **(571) 272-7603**.

Any response to this action should be mailed to:

**Commissioner for Patents**

**P.O. Box 1450**


**Alexandria, VA 22313-1450**

Or faxed to: **(571) 273-8300**.

Hand-delivered responses should be brought to **401 Dulany Street, Alexandria, VA-22314** (Customer Service Window).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 19, 2007

  
Abul K. Azad  
Primary Examiner  
Art Unit 2626